



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,717	01/25/2002	Zine-Eddine Boutaghou	S01.12-0835/STL 10107	3566

7590 08/21/2003

Deirdre Megley Kvale
Westman, Champlin & Kelly
International Centre, Suite 1600
900 Second Avenue South
Minneapolis, MN 55402-3319

EXAMINER

PAIK, STEVE S

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,717

Applicant(s)

BOUTAGHOU ET AL.

Examiner

Steven S. Paik

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 18-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Priority

1. Receipt is acknowledged of claiming the benefit under 35 U.S.C. 119(e) of United States provisional application, 60/264,193 filed 25 January 2001.

Response to Amendment

2. Receipt is acknowledged of the Election and Amendment filed February July 21, 2003. In response to the Restriction Requirement, the applicants have elected Group I (Figs. 1-4). Independent claims 1, 10, and 18 are generic which reads on Figs. 1-4. The applicants inadvertently indicate claims 1-12, 18-20 and 22 read on Figs. 1-4. Since claims 13 and 21 depend on claims 10 and 18 respectively, the examiner has included the claims in the Office Action. The examiner also notes newly added claims 23-27. Accordingly, claims 1-13 and 18-27 have been considered and claims 14-17 are withdrawn from consideration at this time.

Claim Objections

3. Claims 7 and 8 are objected to because of the following informalities: the phrases “relatively uniform size” in claim 7 and “relatively uniformly spaced” in claim 8 fail to claim the invention in a precise manner. The phrases are vague and indefinite. A specific dimension may precisely define the size and space of the claimed bumps. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 2876

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-13, 18-20, and 22-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Bajorek (US 6,482,330).

Re claims 1, 18, and 23, Bajorek discloses a data storage device and method of making the device (col. 1, ll. 6-8) comprising:

a card (a plastic card 10 in Fig. 1B) formed of a non-conductive material; and
a magnetic strip (26 in Fig. 4) carried on the card (Fig. 1B) and including a substrate layer (underlayer 32) and a magnetizable layer (magnetic layer 34) encodable to store digital information (Abstract and col. 1, ll. 9-16) and the magnetic strip including a surface including a textured portion (col. 5, ll. 19-36) having a plurality of spaced bumps (col. 5, ll. 37-41) on a relatively smooth surface of the magnetic strip (26).

Re claim 2, Bajorek discloses the data storage device as recited in rejected claim 1 stated above, wherein the substrate layer includes a surface texture including a plurality of spaced bumps on a portion thereof to form the textured portion of the surface of the magnetic strip (col. 5, ll. 19-36 and Fig. 4).

Re claim 3, Bajorek discloses the data storage device as recited in rejected claim 1 stated above, wherein the magnetic strip (26) includes a protective layer (36) covering the magnetizable layer (magnetic layer 34) and the protective layer includes a surface texture including a plurality of spaced bumps (col. 5, ll. 19-42 and Fig. 4) to form the textured portion of the surface of the magnetic strip (26).

Re claim 4, Bajorek discloses the data storage device as recited in rejected claim 3 stated above, wherein the protective layer is formed of a diamond-like carbon (col. 4, ll. 8-17).

Art Unit: 2876

Re claim 5, Bajorek discloses the data storage device as recited in rejected claim 1 stated above, wherein the substrate layer is formed of a material selected from the group consisting of aluminum, glass or plastic (The glass strip 26 comprises three layers which are underlayer, magnetic layer and protective layer. Bajorek discloses examples of materials that can be used as a magnetic strip in column 5, lines 11-16).

Re claims 6 and 19, Bajorek discloses the data storage device as recited in rejected claims 1 and 18 stated above, wherein the plurality of spaced bumps on the textured portion of the surface of the magnetic strip are laser formed (col. 3, ll. 23-37 and col. 5, ll. 33-41).

Re claims 7 and 8, Bajorek discloses the data storage device as recited in rejected claim 1 stated above, wherein the plurality of spaced bumps (col. 5, ll. 37-41) have a relatively uniform size and relatively uniformly spaced (the sputtering and mechanically forming linear texture process produce the bumps of relatively uniform in size and space).

Re claims 9 and 20, Bajorek discloses the data storage device as recited in rejected claims 1 and 18 stated above, wherein the magnetic strip (26) includes an active surface (upper portion of 26 in Fig. 4) and the active surface includes textured portion including the plurality of spaced bumps (Fig. 4).

Re claims 10 and 11, Bajorek discloses a data storage device (col. 1, ll. 6-8) comprising:
a card (a plastic card 10 in Fig. 1B) formed of a non-conductive material including a magnetic strip (26 in Fig. 4); and

interfacing means for providing a textured interface for the magnetic strip (col. 5, ll. 19-36 and col. 5, ll. 37-41; sputtering process of nickel alloy, such as NiP by depositing it on the glass sheet/strip 26).

Art Unit: 2876

Re claims 12, 13 and 22, Bajorek discloses the data storage device as recited in rejected claims 10 and 18 stated above, wherein the magnetic strip (26) which is affixed on a surface of the card (10) includes a textured protective layer (36) surface including a plurality of bumps (Fig. 4) to form the interfacing means for providing the textured interface for the magnetic strip (col. 4, ll. 23-34 and col. 5, ll. 19-41).

Re claim 24, Bajorek discloses the data storage device as recited in rejected claim 23 stated above, wherein the magnetic strip (26) is on a data card (10).

Re claim 25, Bajorek discloses the data storage device as recited in rejected claim 24 stated above, wherein the texture surface is formed on one of a substrate, the data card or a protective layer (col. 5, ll. 19-36 and Fig. 4).

Re claim 26, Bajorek discloses the data storage device as recited in rejected claim 23 stated above, wherein the texture surface portion includes a plurality of laser formed bumps (col. 3, ll. 23-37 and col. 5, ll. 33-41).

Re claim 27, Bajorek discloses the data storage device as recited in rejected claim 26 stated above, wherein the plurality of laser formed bumps are uniformly sized and/or uniformly spaced (the sputtering and mechanically forming linear texture process produce the bumps of relatively uniform in size and space).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

Art Unit: 2876

skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bajorek (US 6,482,330) in view of Stockburger et al. (US 4,432,567).

Re claim 21, Bajorek discloses a data storage card (10) and a method of storing magnetic data on a magnetic strip (26) having laser formed textured surface portion including a plurality of spaced bumps.

Bajorek, however, is silent about an active surface slideable along the card body surface of the card.

Stockburger et al. disclose a data card such as an identity card, a value card, a credit card, etc. The data card comprises, among other things, a data support 142 provided with a magnetic track (117) and three rectangular recesses (143) for the variable partial surfaces. The plates (144)/strip are slidable within a rectangular recess (143) and are part of the frame and guided on the frame in guides (145) of dovetail type extending transverse to the magnetic track. The plates extending into the recesses are provided with guiding strips 146. When the structured rectangular plates are displaced within the recesses of the data support and corresponding recesses of the frames, the strips are displaced as well, and the extent of displacement is shown by the positions of the studs (147) on the scale (149). In this manner, the plates 144 may be adjusted to different positions which may be read from the scales 149. Depending on the respective positions of the plate 144, different parts of the plates pass into the recording track 117 so that, upon sensing or detecting the recording track 117, a different signal behavior will result (Figs.15-19). Stockburger et al. suggest a method for generating coded information to

Art Unit: 2876

improve authenticity of the data card, and the slidable plates/strip may attribute to protect the data stored in the strip.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to incorporate the slidable strip of Stockburger et al. for the purpose of increasing authenticity of a data storage card holder and protecting data stored in the magnetic strip of the data storage card.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lalonde (US 5,844,230) discloses a magnetic card having a plurality of information sets .

Yano et al. (US 4,977,040) disclose a magnetic card comprising a plurality of magnetic recording layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 703-308-6190. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6893 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0530.

Application/Control Number: 10/056,717
Art Unit: 2876

Page 8

A handwritten signature in black ink, reading "Steven Paik". The signature is fluid and cursive, with the first name "Steven" and last name "Paik" clearly distinguishable.

Steven S. Paik
Examiner
Art Unit 2876

ssp
August 6, 2003